



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,802	07/16/2003	David Haines	21534-002CIP	1462
30623 7590 05/22/2007 MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C. ONE FINANCIAL CENTER BOSTON, MA 02111			EXAMINER FAY, ZOHREH A	
			ART UNIT 1618	PAPER NUMBER
			MAIL DATE 05/22/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/621,802	HAINES ET AL.	
	Examiner	Art Unit	
	Zohreh A. Fay	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 28 February 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 68-83 and 107-113 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 68-83 and 107-113 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

Claims 68-83 and 107-113 are presented for examination.

The amendments and remarks filed on February 28, 2007 have been received and entered.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 107-113 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 107-113 are indefinite as to the phrase "wherein the composition comprising a carotenoid and a polyphenol comprises:". Applicant lists a group of ingredients, which some of them are neither a carotenoid nor a polyphenol.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 68-83 and 107-113 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims are directed to a method of treating "a symptom of dry eye syndrome". Such method requires treatment of unspecified disease and no evidence indicates that treatable disease was known to the applicant. Therefore, the fact pattern indicates that applicant was not in possession of

the claimed method of use. In the absence of understanding the disease to be treated, the artisan would not have accepted that applicant was in possession of the invention. The claims are also directed to a method of treating dry eye using "a carotenoid", a "polyphenol" and "an omega-3 fatty acid". The following precedent is believed to be relevant to the instant case. Regents of the University of California v. Eli Lilly & Co., 119 F.3d 1559, 1568 (Fed. Cir. 1997), cert. Denied, 523 U.S. 1089 S.Ct. 1548 (1998), hold that an adequate written description requires a precise definition, such as by structure, formula, chemical name, or physical properties, "not a mere wish or plan for obtaining the claimed chemical invention." Eli Lilly, 119, F.3d at 1566. The Federal Circuit Court has adopted the standard set forth in the Patent and Trademark Office guidelines for examination of Patent applications under 35 U.S.C. 112 first "written Description" requirement ("Guidelines"), 66 Fed.Reg 1099 (Jan. 5, 2001), which state that a written description can be met by "showing that an invention is complete by disclosure of sufficient detailed, relevant identifying characteristics, "including, *inter alia*, functional characteristics when coupled with a known or disclosed correlation between function and structure...."Enzo Biochem, inc. v. Gen-Probe inc., 296 F.3d, 316 1324-25 (Fed. Cir. 2002) (quoting guideline, 66 Fed Reg. At 1106 (emphasis added). Moreover, although Eli Lilly and Enzo were decided within the factual content of DNA sequences, this does not preclude extending those reasoning of those cases to chemical structures in general. Univ. of Rochester v.G.D. Searle 7 Co., 249 F. supp. 2d 216, 225 (W.D.N.Y.2003).

Applying the reasoning of the above-cited case law to the facts at hand, the instant specification fails to provide an adequate written description of suitable carotenoids, polyphenol compounds and omega-3 fatty acids. The specification describes only a limited number of such compounds. The instant claims generally recite "a carotenoid", "a polyphenol" and "an omega-3 fatty acid". When functional claims are drawn this broadly, they are inclusive of any carotenoid, any polyphenol and any omega-3 fatty acids. Accordingly, the instant specification fails to provide an adequate written description of "a carotenoid", "a polyphenol" and "an omega-3 fatty acid" generally.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zohreh A. Fay whose telephone number is (571) 272-0573. The examiner can normally be reached on Monday to Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/621,802
Art Unit: 1618

Page 5

Z.F



Zohreh Fay